

HT02-016



Application no. 10/706,381

IFW

October 19, 2005

TO: Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Art Unit 2653 - Examiner Kayrish, Matthew

FROM: George O. Saile, Reg. No. 19,572
28 Davis Avenue
Poughkeepsie, N.Y. 12603

SUBJECT: Serial #: 10/706,381
File Date: 11/12/2003
Inventor: Morris Dovek
Examiner: Kayrish, Matthew
Art Unit: 2653
Title: Write-Head having Recessed Magnetic Material in Gap Region

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

This is in response to the Restriction Requirement in the Office Action dated Sept. 19, 2005. In that office action, restriction was required to one of the following Inventions under

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents P.O. Box 1450, Alexandria, VA 22313-1450 on Oct. 19, 2005.

Signature 
Stephen B. Ackerman, Reg. No. 37,761

Date: Oct. 19, 2005

35 U.S.C. 121:

The inventions stated are:

I - Claims 1-28, drawn to a generic write head, classified in class 360, subclass 126, and

II - Claims 29-36, drawn to a process of making write heads of group I.

Applicant provisionally elects to be examined the Invention described by the Examiner as Group I - Claims 1-28, drawn to a generic write head classified in Class 360, subclass 126. This election is made with traverse of the requirement under 37 C.F.R. 1.143 for the reasons given in the following paragraphs.

The Examiner is respectfully requested to reconsider the Requirement for Restriction in the Office Action.

The Examiner gives the reasons for the distinctness between Inventions I and II as (1) that the process as claimed can be used to make other and materially different product, or (2) the product as claimed can be made by another and materially different process (M.P.E.P. 806.05(f)). However, upon reading the process Claims against the product Claims one can readily see that the process Claims are directed to a method of forming "a process to manufacture a magnetic write head", and that the product claims are

directed to "a magnetic write head", and that it is necessary to obtain claims in both the process and product claim language. The process claims necessarily use the product and vice versa. The field of search must necessarily cover both the process class/subclass (unstated) and product class/subclass 360/126, in addition to other related classes and subclasses, to provide a complete and adequate search. The fields of search for Groups I and II are clearly and necessarily co-extensive. The Examiner's suggestion that "in the instant case which the write head has been made by another and materially different process, such as, a process that doesn't require the step of planarizing, for instance", is speculative and has nothing to do with the Claims as presented in this patent application.

Further, it is respectfully suggested that these reasons are insufficient to place the additional cost of second and third patent applications upon the applicants. Therefore, it is respectfully requested that the Examiner withdraw this restriction requirement for these reasons.

Withdrawal of the Restriction Requirement, and allowance of the present Patent Application, is respectfully requested.

It is requested that should there be any problems with this response, please call the undersigned Attorney at (845) 452-5863.

Respectfully submitted,



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